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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,613

Applicant(s)

HAMANN ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Finality Withdrawn:

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Objections:

Claims 8 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Regarding claim 8, a chipcard included in the preamble does not further limit the claimed method step of claim 1. Regarding claim 9, a computer operating system included in the preamble does not further limit the claimed method step of claim 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1 it is unclear what embeds the static object. Furthermore, after embedding, it is unclear by which process the static object is excluded from operations of the file system. In particular, is the static object permanently excluded from all operations? The utility of an embedded static object permanently excluded from dynamic operations is not immediately understandable.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Consider the following excerpt taken from the MPEP:

MPEP § 2164.08(a) Single Means Claim

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor

Claim 10 comprises undue breadth because the following is recited “computer readable program means for causing a computer to perform the method of claim 1.”

Claims 2-9 are rejected for being dependent from a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “embedding one or more static objects in the dynamic file system which are excluded from actions performed dynamically on the file system.” The scope of the invention is difficult to determine because it is unclear if “which are excluded from actions performed dynamically on the file system” refers to the static object or the dynamic file system.

Claim 9 recites “for performing respective steps of the method of claim 1.” As claim 1 consists of a single step, it is unclear what comprises “respective steps” as recited by claim 9.

Claims 2-8 and 10 are rejected for being dependent from a rejected base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,644,766 issued to Coy et al (hereafter Coy).

Claims 1 and 8-10:

Coy discloses embedding one or more static objects [logically clustered collection, col 6, lines 15-60] in the dynamic file system [storage hierarchy, Fig 1, 24] which are excluded from actions performed dynamically on the file system [user initiated operation of the co-location algorithm, col 6, lines 52-60].

Claim 2:

Coy discloses defining an embedded static object by a memory address and a fixed size [col 6, lines 6-15, col 6, lines 45-51]

Claim 3:

Coy discloses creating an embedded static data object by specifying a predetermined storage size, scanning memory for an available storage area large enough in size for receiving the static data object and allocating the storage area for the static object [col 6, lines 45-51]

Claim 4:

Coy discloses creating an embedded object by specifying a storage area having a predetermined memory address and a predetermined storage size, allocating the storage area if it is not being used, and if the area is already in use, moving data using the area to a different memory location and allocating the area thereafter [col 6, lines 52-60]

Claims 5-7:

The claim 5 “used for managing a file system on a chipcard” is drawn to intended use and is not given patentable weight. Claims 6 and 7 depend from claim 5 and thus are not patentable for above reason.

Claims 1-5 and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,549,912 issued to Chen (hereafter Chen).

Claims 1 and 8-10:

Chen discloses embedding one or more static objects [Fig 5, 508] in the dynamic file system which are excluded from actions performed dynamically on the file system [Fig 5, 502 and 503]

Claim 2:

Chen discloses defining an embedded static object by a memory address and a fixed size [Fig 3, 304 and 306, col 8, lines 17-38],

Claim 3:

Chen discloses creating an embedded static data object by specifying a predetermined storage size, scanning memory for an available storage area large enough in size for receiving the static data object and allocating the storage area for the static object [Fig 310 and col 8, lines 39-51]

Claim 4:

Chen discloses creating an embedded object by specifying a storage area having a predetermined memory address [Fig 3, 304, 306, col 8, lines 17-38] and a predetermined storage size [Fig 3, 310], allocating the storage area if it is not being used, and if the area is already in

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use, moving data using the area to a different memory location and allocating the area thereafter
[col 8, lines 45-51]

Claim 5:

Chen discloses a chip card [Fig 5, 502]

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of US Pat No 5,836,010 issued to Kim (hereafter Kim).

Claims 6 and 7:

Chen discloses the elements of claims 1 and 5 as noted above.

Chen fails to disclose accessing a static object in a preboot phase of a host system connected to the chipcard.

Kim discloses accessing a static object in a preboot phase of a host system connected to the chipcard [col 2, lines 15-43].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Chen to include accessing a static object in a preboot phase of a host system connected to the chipcard as taught by Kim.

The ordinarily skilled artisan would have been motivated to modify Chen per the above for the purpose of restricting unauthorized access to the computer system [col 2, lines 16-20].

Response to Arguments

Applicant's arguments filed 4/26/2004 in the Appeal Brief have been fully considered and are partially persuasive. In an attempt to apply the best art against very broad claim language, supra new art rejections are provided. Furthermore, above new art rejection minimizes points of view regarding the claimed "dynamic file system."


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

6/14/2004 


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